

REMARKS

Claims 10, 11, 15, 17, 18, 20-22, 24-28, 30, and 31 are pending in the present application. Claim 29 is hereby canceled. Claims 30 and 31 are new. Claims 10, 20, 27, and 28 have been amended. Claims 10, 27, and 28 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

Rejection Under 35 U.S.C. § 103

Independent Claims 10 and 28:

Independent claim 10, and dependent claims 20-22, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0119762 to Denoue (hereafter “Denoue”) in view of U.S. Patent No. 7,042,594 to Dawe et al. (hereafter “Dawe”) and U.S. Patent Application Publication No. 2008/0046837 to Beauchamp et al. (hereafter “Beauchamp”). Claim 28 stands rejected under § 103(a) as being unpatentable over Dawe in view of Beauchamp and Denoue. These rejections, insofar as they pertain to the presently pending claims, are respectfully traversed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In the Amendment filed December 30, 2008, Applicants amended independent claims 10 and 28 to recite the features of “receiving a user command to annotate the content displayed within the on-screen region” and “in response to the user command, receiving an annotation drawn by the user via the stylus.” In the current rejections, the Examiner argues that Beauchamp teaches these features. Particularly, the Examiner asserts that

“Beauchamp teaches that at step 150 in Figure 1B, a user selects to enter pen annotations or non-pen annotations, i.e. by a mouse click, and in response, to the

user selecting to enter pen-annotations, user input is generated (step 156)” (Office Action at page 19, last paragraph).

Without conceding the validity of the Examiner’s rejection, Applicants have amended independent claims 10 and 28 to further distinguish over the aforementioned references, in an effort to expedite prosecution. Amended claims 10 and 28 now recite **different modes of operation for interpreting stylus input** including: a **content capture mode** for selecting the on-screen region, and an **annotation mode** for annotating contents of the selected on-screen region. Further, amended claims 10 and 28 recite receiving a user command to set the mode of operation to the annotation mode and, **in response to receiving such command, switching to the annotation mode** and receiving an annotation drawn via the stylus. Such amendments are supported in the specification at, e.g., paragraphs 44-45 and 49.

None of Denoue, Dawe, and Beauchamp teaches or suggests different modes for interpreting stylus input, including one for selecting an on-screen region for content capture and another for receiving an annotation. As such, none of these references teaches or suggests receiving a user command to set the mode of operation for interpreting stylus input to the annotation mode and, in response thereto, switching the mode of operation so as to receive an annotation via the stylus. Therefore, the cited references fail to teach or suggest every claimed feature in independent claims 10 and 28.

At least for the reasons set forth above, Applicants respectfully submit that independent claims 10 and 28 are in condition for allowance. Accordingly, claims 20-22 are allowable at least by virtue of their dependency on independent claim 10. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Independent Claim 27:

Independent claim 27, along dependent claim 24, stand rejected under § 103(a) as being unpatentable over Denoue, in view of Dawe and U.S. Patent Application Publication No. 2002/0076109 to Hertzfeld et al. (hereafter “Hertzfeld”).

Initially, Applicants point out that claim 27 has been amended to incorporate the subject matter of dependent claim 29. Furthermore, Applicants wish to reemphasize that **all** the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of obviousness.

Independent claim 27 requires **storing in association with the image file** an extracted property of the underlying data comprising at least one of: a file name, a file identifier, a uniform resource locator (URL), a uniform resource identifier (URI), a folder name, and meta-data. The above-cited references, taken separately or in obvious combination, do not teach or suggest such features. In fact, the Examiner does not even assert that any of the cited references teaches such a feature.

In this rejection, the Examiner cites to Hertzfeld to teach automatically **extracting** a web address. However, Hertzfeld does **not** teach or suggest **storing** the web address in association with an image file. In an attempt to remedy this deficiency, the Examiner asserts the following:

“Hertzfeld teaches that when the text represents a web address, the web address is extracted and the web page is displayed. Dawe teaching [sic] storing context in association with the image file; thus, when combined, Dawe would store the recognized web address as context” (Office Action at page 15, 2nd paragraph).

Applicants respectfully, but strongly, disagree with the Examiner’s conclusion. Particularly, there is no logical basis for the Examiner’s assertion that “when combined, Dawe would store the recognized web address as context.”

Hertzfeld does **not** teach or even suggest that extracting the web address for the purpose of providing “context” for an image file. Furthermore, Dawe’s teachings are limited to storing **text-recognized handwritten annotations** in association with a document; Dawe does **not** teach or suggest storing any other type of data in association with the document. In fact, Dawe does not even suggest that the annotations are stored to provide “context” for the document.

Therefore, it would **not** logically follow to combine Dawe and Hertzfeld to store a web address in association with an image file. Instead, the Examiner's proposed combination is based on impermissible hindsight, using Applicants' disclosure as a blueprint.

However, in an effort to expedite prosecution, independent claim 27 has been amended to even further distinguish over the cited references. Particularly, this claim has been amended to recite that the step of automatically determining that the displayed content of the on-screen region includes the underlying data is performed "by using an application programming interface (API) to query an application window associated with the content of the selected on-screen region." None of the cited references, taken separately or in obvious combination, teach or suggest this feature.

In the rejection, the Examiner cites to Fig. 6 (step 608) and paragraph 38 of Hertzfeld as teaching the step of automatically determining whether the displayed content of the on-screen region includes underlying data (see Office Action at page 13). However, Hertzfeld's invention merely parses input text to determine whether the text's format matches the format of a world wide web address (see Hertzfeld at paragraph 0035). There is **no teaching or suggestion in Hertzfeld of using an API** to query an application window to determine whether the input text is a web address. Furthermore, this would not be an obvious modification of Hertzfeld – instead, such modification would **impermissibly change Hertzfeld's principle of operation.**¹

It is respectfully submitted that the aforementioned claim features are neither taught nor suggested by Denoue, Dawe, Beauchamp, and Hertzfeld, taken separately or in obvious combination. At least for this reason, independent claim 27 is in condition for allowance. Accordingly, claim 24 is allowable at least by virtue of its dependency on claim 27. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

¹ See MPEP § 2143.01.VI, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

Remaining Dependent Claims:

Claims 11, 25, and 26 stand rejected under § 103(a) as being unpatentable over Denoue, Dawe, and Beauchamp, and further in view of U.S. Patent No. 6,334,157 to Oppermann et al. (hereafter "Oppermann"). Claims 15 and 18 stand rejected under § 103(a) as being unpatenable over Denoue, Dawe, and Beauchamp, and further in view of U.S. Patent Application Publication No. 2004/0135815 to Browne et al. (hereafter "Browne"). Claim 17 stands rejected under § 103(a) as being unpatentable over Denoue, Dawe, and Beauchamp, and further in view of U.S. Patent Application Publication No. 2003/0101156 to Newman (hereafter "Newman").

It is respectfully submitted that none of Oppermann, Browne, and Newman remedies the deficiencies of Denoue, Dawe, and Beauchamp set forth above in connection with independent claim 10. Accordingly, claims 11, 15, 17, 18, 25, and 26 are allowable at least by virtue of their dependency on independent claim 10. Therefore, the Examiner is respectfully requested to reconsider and withdraw these rejections.

Conclusion

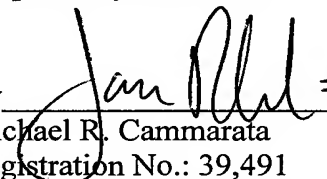
In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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